REMARKS

Claims 1-36 are pending in the present application. Claims 9, 21, 25, 29, 30, and 32-36 are amended. Reconsideration of the claims is respectfully requested.

I.   Interview Summary

On May 3, 2005, the undersigned attorney and Examiner Tran discussed the anticipation rejection of claim 1. The parties also discussed the meaning of the term "transcript" in the claims. No agreement was reached.

During the interview, Examiner Tran requested that support for the term "transcript" be pointed out in the specification. The term "transcript" and its use in the context of the claimed invention is described in the specification on page 12, line 10 through page 15, line 12.

II.   35 U.S.C. § 102, Anticipation

The examiner has rejected claims 1-5, 8-17, 20-29 and 32-36 under 35 U.S.C. § 102(e) as anticipated by *Gatz* et al., Parental Control System For Use In Connection With Account Based Internet Access Server, U.S. Patent Application 2002/0049806 (Apr. 2002). This rejection is respectfully traversed.

Regarding claims 1, 13, and 25 the examiner states that:

> With respect to claims 1, 13, and 25, *Gatz* teaches a method of monitoring use of an instant messaging user account (see abstract and figures 2-3), comprising:
>> receiving an instant message (paragraph 0044-0045);
>>
>> determining if a transcript of the instant message is to be stored (paragraph 0015);
>>
>> storing the transcript of the instant message in a storage device (paragraph 0047) if a transcript of the instant message is to be stored (paragraph 0049); and
>>
>> providing the transcript to a designated monitor of the instant messaging user account (paragraph 0049 i.e. "allow parental monitoring of such activity").

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Claim 1 provides as follows:

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1.   A method of monitoring use of an instant messaging user account, comprising:

    receiving an instant message;

    determining if a transcript of the instant message is to be stored;

    storing the transcript of the instant message in a storage device if a transcript of the instant message is to be stored; and

    providing the transcript to a designated monitor of the instant messaging user account.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case each and every feature of the presently claimed invention is not identically shown in the cited reference , arranged as they are in the claims.

Gatz does not anticipate claim 1 because *Gatz* does not show each and every step of claim 1. For example, *Gatz* does not show the step of determining if a transcript of the instant message is to be stored. The examiner asserts otherwise, indicating paragraphs 14 and 15 of *Gatz*.[1] That section of *Gatz* provides as follows:

[0014] The present invention provides an account based access control system allowing the holder of one account to control the ability of one or more other account holders to access information in an information network. Thus, it is possible for parents to establish parental accounts that can be used to control the access of their children (having child accounts) to information provided over the Internet. In effect, the parent creates a "family" account with the online server. The server includes logic and data storage that allows the server to track account identifiers (IDs) for each child in the family. With the family account, a parent that controls the family account (the "controlling parent") can add a child to the family account with a new child account, attach an existing child account to

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[1] Although the office action refers to paragraph 15 of *Gatz*, during the examiner interview the examiner indicated that the proper citation should be to paragraphs 14 and 15 of *Gatz*.

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the family account, modify a child's password, account information or other information (e.g., preferences, stored items) saved at the online system in association with a specific account, modify their child's email block lists, friend "buddy" lists and instant message ignore lists, or sign in as the child in order to be aware of and modify any aspect of the child's account. It should be understood that a "parent-child" relationship as described herein is not only familial as to human beings, but also is taxonomic as to hierarchical arrangement of accounts.

[0015] In one embodiment of the present invention, an access server controls use of services in an account based access server and includes a database of users, a link table associating users identified as parents with parent accounts, users identified as children with child accounts and associating parent accounts with child accounts in family accounts. The access server includes logic for verifying parental status of a parent account with respect to a child account and logic for limiting access to a user using a child account that is associated with a family account, where such limitations are determined, at least in part, based on selections made by a user of a parent account associated with the family account.

Gatz, paragraphs 14-15.

Nowhere in the cited text does *Gatz* discuss the step of determining if a transcript of the instant message is to be stored. Although other sections of *Gatz* may show storing data related to Internet transactions, *Gatz* does not actually show a step of determining if a transcript of the instant messaging is to be stored in the first place. Nowhere in *Gatz* does *Gatz* actually show or suggest the step of determining if the transcript is to be stored. Thus, *Gatz* does not anticipate claim 1.

For similar reasons, *Gatz* does not anticipate claim 13, which contains similar limitations to claim 1. In addition, although claim 25 has been amended to replace the term "transcript" with the term "log," *Gatz* still does not teach the step of determining if a log of the instant message is to be stored. Thus *Gatz* does not anticipate claims 1, 13, or 25. For similar reasons, *Gatz* does not anticipate any of the dependent claims upon which claims 1, 13, and 25 depend, including claims 2-5, 8-12, 14-17, 20-24, 26-29, and 32-36. Accordingly, the rejection of claims 1-5, 8-17, 20-29, and 32-26 under 35 U.S.C. 102(e) has been overcome.

With respect to claim 25 and its related dependent claims, *Gatz* does not anticipate claim 25 as amended because *Gatz* does not show determining if a log of the instant

message is to bc storcd, storing the transcript of the instant message in any storage device, or providing the log to a designated monitor of the instant message user account as claimed. Although *Gatz* does discuss allowing a parent to monitor thc activities of a child, *Gatz* only discusses monitoring which users the child may interact with. *Gatz* never shows or suggests providing the actual contents of the log to a parent or anyone else. Thus *Gatz* does not anticipate claim 25 as amended.

With respect to claim 29, *Gatz* does not teach analyzing the log to identify at least one characteristic of the log. With respect to claim 33, *Gatz* does not teach that at least one charactcristic includes the list provided for in claim 33. With respect to claim 34, *Gatz* does not teach wherein analyzing the log includes the filtering for text including at least one of the items provided for in the list in claim 34. Similar arguments can be made with respect to claims 32, 35, and 36. Thus, the rejection of claims 25-29, and 32-36 under 35 U.S.C. §102(e) has been overcome.

Because claims 2-6, 8, 11, 14-18, 20, and 23 depend from claims 1 and 13, the same distinctions betwccn *Gatz* and the claimed invention in claims 1 and 13 can be made for these claims. Consequently, it is respectfully urged that the rejection of claims 2-6, 8, 11, 14-18, 20, and 23 have been overcome.

Furthermore, *Gatz* does not tcach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Gatz* actually tcaches away from the presently claimed invention because *Gatz* teaches simple techniqucs of monitoring with whom a child may be interacting during instant messaging as opposed to a dctermining if a transcript of the instant mcssages is to be stored, as in thc presently claimcd invention. Absent the examiner pointing out some teaching or incentive to implement *Gatz* and determining if a transcript of the instant message is to be stored, one of ordinary skill in thc art would not be led to modify *Gatz* to reach the prescnt invention when the refereoce is examined as a whole. As shown bclow, no such teaching, suggestion, or incentivc cxists. Absent some teaching, suggestion, or incentive to modify *Gatz* in this manner, the presently claimed invention can be rcached only through an improper use of hindsight using Applicants disclosure as a tcmplatc to make the necessary changes to reach thc claimed invention.

III.   35 U.S.C. § 103, Obviousness

The examiner has rejected claims 6-7, 17-19 and 30-31 under 35 U.S.C. § 103(a) as being unpatentable over *Gatz* in view of *Donahue*, Employee Internet Management Device, U.S. Patent Publication 2002/0004907 (Jan. 10, 2002) (hereinafter *"Donahue"*). This rejection is respectfully traversed.

IIIA.   Rejection of Claims 6, 18 and 30

Regarding claim 6, 18, and 30, the examiner states that

> With respect to claims 6, 18 and 30, *Gatz* fails to teach providing the transcript to a designated monitor includes transmitting the transcript as an attachment to an electronic mail message.
>
> In a method of monitoring, *Donahue* discloses providing the transcript to a designated monitor includes transmitting the transcript as an attachment to an electronic mail message (paragraphs 0013-0014).
>
> Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify *Gatz* in view of Donohue by transmitting the transcript as an attachment to an electronic mail message because this feature "may need to be converted, where possible, to a format containing text, and analyzed separately" (paragraph 0014). It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify *Gatz* in view of Donohue in order to send or notify the parent (i.e. designated monitor) the log date (i.e. the transcript of his/her child) in efficient and costless.

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Claim 6 which is representative of claims 18 and 30 provides as follows:

> 6.   The method of claim 1, wherein providing the transcript to a designated monitor includes transmitting the transcript as an attachment to an electronic mail message.

The examiner has failed to state a *prima facie* obviousness rejection of claims 6, 18, and 30 because the proposed combination does not result in the claimed inventions. As shown with respect to the anticipation rejections of claim 1, *Gatz* does not show all the limitations of the independent claims from which claims 6, 18, and 30 depend. *Donahue* fails to cure the deficiencies of *Gatz* in this regard. Because the references do

not show or suggest all the limitations of claims 6, 18, and 30, the examiner has failed to state a *prima facie* case of obviousness against these claims.

In addition, the examiner states that *Donahue* discloses that writing of the transcript to a designated monitor includes transmitting the transcript as an attachment to an electronic mail message, citing paragraphs 13-14 of *Donahue*. However, the examiner misapprehends *Donahue*. *Donahue* does not teach providing the transcript as an attachment to an electronic mail message as asserted by the examiner. Instead. *Donahue* merely discusses analyzing an attachment to an electronic message as part of analyzing the electronic message itself. The text of paragraphs 14 and 15 is as follows:

> [0014] Some protocols transfer multiple independent data streams within a single tcp session. For example the SMTP protocol supports the transmission of multiple unrelated emails in one tcp session. If the log data is identified as being associated with one of these protocols, each independent part of the log is processed individually. Even these independent portions of the log may need to be broken down further into smaller pieces. *For instance, email may contain multiple documents in the form of attachments, which may need to be converted, where possible, to a format containing text, and analyzed separately.* (emphasis added)

> [0015] Each log, or independent portion of the log is then processed by the "categorize" subroutine which is illustrated in the flow diagram of FIG. 2. First, the data is stripped of any content which does not appear to contain language elements. The remainder, i.e., text containing language elements, is stored as a string of language elements separated by spaces. This allows the language elements or text to be effectively searched regardless of its original formatting. In example 1, addressed below, an email message is processed. Note that in email, quotation of prior email references are commonly preceded by numerous "greater than signs" (>), which are stripped in this step.

Donahue, paragraphs 14-15.

As *Donahue* explains, the email is being analyzed to determine whether or not the email matches the current set of user-selected criteria. As part of that analysis, the attachments to that email are also analyzed for the user-selected criteria. However, the transcript of an instant message is not transmitted via an email, as asserted by the examiner. *Gatz*, as admitted by the examiner, also fails to show this claimed feature. Therefore, the

proposed combination does not result in the claimed invention. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection of claims 6, 18, and 30.

In addition, the examiner has failed to state a *prima facie* case of obviousness because the examiner has failed to state a proper motivation to combine the references. The examiner asserts that the motivation to combine *Gatz* and *Donahue* is found in the last sentence of paragraph 14 of *Donahue*, which is as emphasized above. However, in view of the fact that *Donahue* does not actually teach what the examiner states *Donahue* teaches, the proposed motivation makes no sense. Thus, the proposed motivation is not a motivation at all and cannot be used to establish a *prima facie* case of obviousness.

In addition, because the proposed motivation is non-existent in *Donahue*, the examiner must have merely selected elements from different references and combined them together without having a sufficient pre-existing motivation to do so. Thus, the examiner must have used impermissible hindsight when fashioning the rejection. Thus, again, the examiner has failed to state a proper motivation to combine the references and has failed to state a *prima facie* case of obviousness.

In addition, claim 6, 18, and 31 are non-obvious in view of *Gatz* and *Donahue* because the references address different problems. For example, *Gatz* is directed towards a parental control system for use in connection with account based Internet access servers. See the abstract in *Gatz*, which is as follows:

> An access server controls use of services in an account based access server and includes a database of users, a data structure associating users identified as parents with parent accounts, users identified as children with child accounts and associating parent accounts with child accounts in family accounts. The access server includes logic for verifying parental status of a parent account with respect to a child account and logic for limiting access to a user using a child account that is associated with a family account, where such limitations are determined, at least in part, based on selections made by a user of a parent account associated with the family account.

Gatz, Abstract.

On the other hand, *Donahue* shows an employee monitoring system for use on a local area network. For example, see the abstract in *Donahue*, which provides as follows:

> The present invention relates to a system for monitoring and maintaining an acceptable use policy for network communications.

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> Such communications are monitored, stored and searched for the presence of preselected regular expressions, either by subject category or by keywords. The regular expressions within the subject categories are assigned predetermined values, either negative or positive. If a communication contains regular expressions whose sum of weighted values exceeds a threshold value, the communication is stored for subsequent review by an authorized user of the system. If the communication contains keywords selected by the authorized user, the communication is also stored for subsequent review.

Donahue, Abstract.

As can be plainly seen from the abstract of each reference, the references are directed towards solving different problems. Thus, when the references are viewed together as a whole, one of ordinary skill would have no reason or motivation to combine them. Accordingly, claim 6 is non obvious in view of *Gatz* and *Donahue*.

Similarly, both *Gatz* and *Donahue* represent a complete solution to the problem that each reference solves. As described above, *Gatz* is directed towards a parental control system for use in connection with an account-based Internet access server and *Donahue* is directed towards an employee-monitoring device. Each reference provides a complete solution to the problem that each reference addresses. Thus, one of ordinary skill would have no reason or motivation to combine the references. Accordingly claims 6, 18, and 31 are non obvious in view of *Gatz* and *Donahue*.

IIIB.   Claims 7, 19, and 31

Regarding claim 7, 19, and 31, the examiner states that:

> With respect to claims 7, 19, and 31, *Gatz* fails to teach the electronic mail message is transmitted in response to a request from the designated monitor.
>
> In a method of monitoring, *Donahue* discloses the electronic mail message is transmitted in response to a request from the designated monitor (paragraph 0006 i.e. The stored session can then be viewed, downloaded and/or deleted by the user which is inherent as the user "i.e. the designated monitor" requested the transmitted electronic mail message "i.e. stored sessions").
>
> Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify *Gatz* in view of *Donahue* by transmitting in response to request from designated

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monitor because this feature "may need to be converted, where possible, to a format containing text, and analyzed separately" (paragraph 0014). It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify *Gatz* in view of *Donahue* in order to send or notify the parent (i.e. designated monitor) the log data (i.e. the transcript of his/her child) in efficient and costless.

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Claim 7 provides as follows:

7.   The method of claim 6, wherein the electronic mail message is transmitted in response to a request from the designated monitor.

The examiner failed to state a *prima facie* obviousness rejection of claims 7, 19, and 31 because the proposed combination does not result in the claimed inventions. As shown above, neither *Gatz* nor *Donahue* show all the limitations of the claims from which claims 7, 19, and 31 depend. In addition, the examiner has failed to state a proper motivation to combine the references. The proposed motivation offered by the examiner makes no sense in view that *Donahue* does not show providing the transcript as an email attachment as claimed, as discussed above. For these reasons, the examiner has failed to state a *prima facie* case of obviousness against claims 7, 19, and 31.

Furthermore, claims 7, 19, and 31 are non obvious in view of *Gatz* and *Donahue*. As described above, *Gatz* and *Donahue* solve different problems and each reference represents a complete solution to the problem that each reference solves. Thus, one of ordinary skill would not have a reason or motivation to combine the references in the manner suggested by the examiner. Accordingly, claims 7, 19, and 31 are non obvious in view of *Gatz* and *Donahue*.

IV.   Objection to Claims

The examiner objects to claims 9, 21, and 33 because of informalities in those claims, as asserted in the office action. Applicants have amended the claims accordingly, thereby overcoming the objections.

V.   Conclusion

It is respectfully urged that the subject application is patentable over *Gatz* and *Donahue* and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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